

ESTTA Tracking number: **ESTTA1150**

Filing date: **06/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198858
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Date	06/11/2013
Attachments	CaseCentral - opposer's reply brief.pdf(308337 bytes) CaseCentral - response to objection to RJN.pdf(142611 bytes) Certificate of Service.pdf(61500 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CASECENTRAL, INC.,)	
)	Mark: PRESERVATION
)	CLOUD
)	
vs.)	Serial No.: 77/922,469
)	
NEXTPOINT, INC.,)	Opposition No. 91198858
)	
)	
Applicant.)	Published in the Official
)	Gazette on November 9, 2010
)	

OPPOSER CASECENTRAL, INC.'S REPLY BRIEF ON THE CASE

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Pursuant to 37 C.F.R. § 2.128(a), and the Board's Order Extending Opposer's Time to File Reply Brief on the Case dated May 18, 2013, Opposer CaseCentral, Inc. ("CaseCentral") hereby submits the following Reply Brief.

INTRODUCTION

Despite describing itself as "a leader in delivering cloud computing products and services to the legal industry" (Opposer's Notice of Reliance No. 1, Oct. 5, 2012 ("Opp. NOR"), Exh. 7), and stating that its "world-class, cloud-based platform answers the unique legal, regulatory, and compliance requirements posed by data stored 'in the cloud'" (*id.* Exh. 10), Nextpoint now claims that the word "cloud," and the phrase "Preservation Cloud" taken as a whole, are essentially meaningless and convey no information about Nextpoint's services.

This argument cannot be squared with Nextpoint's own marketing materials, which repeatedly assert that Nextpoint's "Cloud Preservation" and "Preservation Cloud" services are intended to "preserve" data by way of "cloud computing," and thus reflect that the Mark describes one or more features of those services. (*See, e.g.*, Applicant's Notice of Reliance No. 1, Dec. 6, 2012 ("App. NOR"), Exh. 4, at NEXT 1070 (Preservation Cloud is a "storage and processing resource to preserve and manage large volumes of ESI"); *id.* Exh. 5, at NEXT 1118 (Preservation Cloud's purpose is the "preservation of confidential data," and it "leverages cloud computing technology"); *id.* Exh. 6 (Preservation Cloud is part of Nextpoint's "cloud-based platform").)

Nextpoint's remaining assertions on the issue of the Mark's descriptiveness distort the applicable legal standards.

First, Nextpoint maintains that "Preservation Cloud" would not be descriptive in the eyes of the "public at large," but the relevant issue is whether, from the perspective of

entities in search of litigation support services, the Mark describes the features of Nextpoint's offerings. *See In re Omaha Nat'l. Corp.*, 819 F.2d 1117, 1119 (Fed. Cir. 1987) (relevant question is whether "the class or classes of actual or prospective customers of the applicant's particular goods or services" would see mark as descriptive).

Second, Nextpoint asserts that the word "cloud," without more, suggests nothing more than a vague association with the internet. However, the relevant question is not what the word "cloud," standing alone, would mean to an average consumer of Nextpoint's services, but how such a consumer would interpret the term in the context of Nextpoint's marketing materials and other available information. *See In re BetaBatt, Inc.*, 89 U.S.P.Q.2d 1152, 2008 WL 5232795, *3 (TTAB Dec. 15, 2008) ("[T]he question is not whether someone presented only with the mark could guess what the products and services are. Rather, the question is whether someone who knows the products and services will understand the mark to convey information about them.").

Third, Nextpoint claims the phrase "Preservation Cloud" is not descriptive because Nextpoint is the only user of that term. Nextpoint is factually incorrect. (*See, e.g.,* Opp. NOR Exh. 18 (article on "Digital Preservation Cloud Services").) In any event, whether others use the phrase "Preservation Cloud" is irrelevant. *See In re Hunter Fan Co.*, 78 U.S.P.Q.2d 1474, 2006 WL 479001, *3 (TTAB Feb. 15, 2006) ("[A] word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods does not imbue the term with source-identifying significance.").

Finally, Nextpoint asserts that, because the U.S. Patent and Trademark Office ("USPTO") has registered other marks containing the word "cloud," registration of the

Mark must also be appropriate. However, the Board has repeatedly held to the contrary. *See, e.g., In re Styleclick.com Inc.*, 58 U.S.P.Q.2d 1523, 2001 WL 245735, *4 (Feb. 12, 2001) (“[T]he determination of registrability of particular marks by the Trademark Examining Groups cannot control the result in another case involving a different mark for different goods and/or services.”).

As to Nextpoint’s bona fide intent to use the Mark in commerce, Nextpoint makes no attempt to rebut CaseCentral’s evidence that (1) after Nextpoint discovered in March 2010 that CaseCentral’s Christopher Kruse owned the preservationcloud.com domain name, Nextpoint stopped using the Mark on its website and in its marketing documents; (2) no Nextpoint client is presently using a product called “Preservation Cloud”; and (3) Nextpoint is uncertain of when it supposedly intends to use the Mark again. Instead, Nextpoint claims that, as long as Nextpoint intended to use the Mark at the time of its application, the Mark is registrable, regardless of whether Nextpoint later decided not to use it. Nextpoint is mistaken. *See, e.g., Spirits Int’l., B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 U.S.P.Q.2d 1545, 2011 WL 2909909, *3 (TTAB Jul. 6, 2011) (registration must be refused if the “applicant lacked on the filing date of the application, *or now lacks*, a bona fide intent to use the mark on the identified goods”) (emphasis added).

Moreover, Nextpoint relies on documents dating from *before* March 2010 to show its alleged, present intent to resume using the Mark. This evidence does not meet the requirement that Nextpoint possess, *at present*, “‘a written plan of action’ for a new product or service” to be designated by the Mark. *Bobosky v. Adidas AG*, 843 F. Supp.

2d 1134, 1140 (D. Or. 2011) (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19.14, at 19-46, 47 (4th ed. Rev. 2011)).

Nor can Nextpoint rely on the mere assertions of its executives, CEO Rakesh Madhava and Marketing Director Michael Beumer, that Nextpoint intends to use the Mark again at an unknown future time. *See Loreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 2012 WL 1267956, *13 (Mar. 20, 2012) (“Applicant’s mere statements that he intends to use the mark L’OREAL PARIS, and his denial that he lacked a bona fide intent, do not establish, in fact, that he had a bona fide intent to use the mark in commerce . . .”).

ARGUMENT

I. THE MARK IS DESCRIPTIVE OF NEXTPOINT’S SERVICES

To determine that the Mark merely describes Nextpoint’s services, the Board “need only find that” the Mark “immediately conveys information about one feature or characteristic of at least one of the designated services within . . . [Nextpoint’s] application[.]” *In re Chamber of Commerce*, 685 F.3d 1297, 1301 (Fed. Cir. 2012); *see also In re Sun Microsystems, Inc.*, 59 U.S.P.Q.2d 1084, 2001 WL 461279, *4 (TTAB Mar. 28, 2001) (“It is not necessary that a term describe all of the properties or functions of the goods in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them.”). The Mark meets this requirement because, from the perspective of a consumer seeking electronic litigation support, the Mark describes the use of *cloud* computing to *preserve* data.

This is the case regardless of whether Nextpoint uses the Mark to describe (1) its service for archiving social media data (the “Archiving Service”) or (2) its allegedly separate “Preservation Cloud” service that preserves “large volumes of ESI,” *i.e.*,

electronically-stored information, in the cloud (App. NOR Exh. 5). As Madhava put it, the salient distinction between those two products is that “Cloud Preservation is a collections tool for data that is currently in the cloud,” while “Preservation Cloud is a place to put data in the cloud that is not in the cloud, but has been collected locally.” (Madhava Dep. 28:3-7; *see also id.* at 23:15-24.) In other words, although Cloud Preservation and Preservation Cloud acquire data from different sources (the former from the internet, and the latter from the user’s local drive), they store it in the same manner, *i.e.*, “in the cloud” (on a remote server). (*Id.*)

Thus, both purported products use cloud computing — storing data, and making it accessible, on an online server, as opposed to the data owner’s local computer drive — to preserve data. *See, e.g., Int’l. Bus. Machs. Corp. v. Visentin*, No. 11 Civ. 399, 2011 WL 672025, *5 (S.D.N.Y. Feb. 16, 2011) (“Cloud computing allows businesses and individuals to use the Internet to access software programs, applications, and data from computer data centers managed by providers such as IBM and HP.”).

A. Nextpoint’s Reliance on the “General Public’s” Purported Understanding of “Preservation Cloud” Is Misplaced

Nextpoint asserts that, “[w]hile the term ‘cloud computing’ may have certain technical implications to IT professionals, . . . to the public at large it remains, at best, a buzzword suggesting Internet savviness.” (App. Br. at 12.) Nextpoint goes on to cite articles concerning the general public’s understanding of “cloud computing,” such as a survey stating that “51% [of Americans surveyed] believe stormy weather would interfere with their cloud computing.” (*Id.*)

However, the relevant question is not whether the “public at large” would understand the Mark as descriptive of Nextpoint’s services, but whether “the class or

classes of actual or prospective customers of the applicant’s particular goods or services” would have that understanding. *In re Omaha Nat’l. Corp.*, 819 F.2d at 1119; *see also Goodyear Tire & Rubber Co. v. Continental Gen’l. Tire, Inc.*, 70 U.S.P.Q.2d 1067, 2003 WL 21382464, *14 (TTAB Jun. 11, 2003) (INTELLIGENT mark, as applied to tires, was descriptive, as “[t]he bulk of the evidence in this record points to a clear descriptive meaning among the key players in the auto and tire industries”); *In re Sun Microsystems, Inc.*, 2001 WL 461279, *4 (AGENTBEANS mark was descriptive, because “[a]nyone marketing software ‘beans’ which have the attributes of ‘agent’ programs, or can be used to construct such programs would, we think, have occasion to use the term AGENTBEANS to convey such fact”).

By Nextpoint’s admission, the potential purchasers of Preservation Cloud are “law firms, corporations, and governments” who wish to “store electronic data pertinent to their litigations” — not the general public. (Madhava Dep. 5:3-11.) Thus, the relevant issue is whether parties to a litigation in search of an electronic discovery application would regard “Preservation Cloud” as descriptive of Nextpoint’s services.

B. The Term “Preservation Cloud,” to a Litigant Searching for an Electronic Discovery Vendor, Would Describe the Use of Cloud Computing to Preserve Data

1. The word “cloud”

Despite Nextpoint’s extensive advertising emphasizing the key role of cloud computing in its offerings, Nextpoint asserts that, “[t]o the primary consumers of litigation support software, the word ‘cloud’ is likely to do little more than suggest that Nextpoint’s services have a fashionable, cutting-edge association with the Internet.” (App. Br. at 13.) However, the proper approach is not to interpret the Mark in a vacuum,

but in the context in which Nextpoint actually uses it — *i.e.*, in its marketing documents. *See In re BetaBatt, Inc.*, 2008 WL 5232795, *3 (“[T]he question is not whether someone presented only with the mark could guess what the products and services are. Rather, the question is whether someone who knows the products and services will understand the mark to convey information about them.”); *In re Styleclick.com Inc.*, 2001 WL 245735, *2 (“[W]hether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought,” and “the context in which it is being used on or in connection with those goods and/or services . . .”).

Even assuming “Preservation Cloud” is a product distinct from the Archiving Service, Nextpoint’s marketing claims make clear that “cloud,” as used in the Mark, is not simply meant to vaguely reference the internet, but to refer specifically to “cloud computing” — which, as noted above, refers to storing data, and making it accessible, on a remote server. These statements include Nextpoint’s assertions that Preservation Cloud (1) utilizes a “cloud computing platform” (App. NOR, Exh. 4, at 3); (2) “leverages cloud computing technology to realize more cost-effective preservation of confidential data” (*id.* Exh. 5, at 1); and (3) is part of Nextpoint’s “cloud-based platform” (*id.* Exh. 6).

Nextpoint cannot plausibly argue that “cloud” has no meaning when Nextpoint uses the term so frequently to describe features of its offerings. *See In re Masco Corp. of Am.*, No. 77331673, 2011 WL 2214920, *2 (TTAB May 24, 2011) (applicant’s DIAMOND SEAL TECHNOLOGY mark was descriptive, because “Applicant’s own marketing materials and web site describing the goods emphasize the use of microscopic diamonds as the key component as part of an innovative technology to create a sealant”); *In re Westminster Int’l. Co.*, 23 U.S.P.Q.2d 1958, 1992 WL 233380, *1 (TTAB Jul. 16,

1992) (citing “numerous references by applicant . . . using the words sought to be registered in descriptive and generic ways” as evidence of descriptiveness of mark); *In re Pennzoil Prods. Co.*, 20 U.S.P.Q.2d 1753, 1991 WL 326581, *3 (TTAB Aug. 21, 1991) (“[T]here could be no doubt as to the merely descriptive significance of the term ‘MULTI-VIS’ to purchasers . . . of applicant’s goods since” containers of applicant’s motor oil used the phrase “[a] gas saving multi-viscosity oil providing fast cold weather starts and high temperature protection” next to the MULTI-VIS mark).

Nextpoint further maintains that “there is nothing distinctive about the fact that Applicant’s services utilize remote servers, a characteristic by definition shared with every online service.” (App. Br. at 12.) This is a non sequitur — the issue is whether the Mark describes a feature of Nextpoint’s services, not whether those services are unique. *In re Chamber of Commerce*, 685 F.3d at 1301. Moreover, this notion is at odds with Nextpoint’s marketing claims that its provision of cloud-based litigation support services *does* make Nextpoint unique — for instance, Nextpoint’s assertions that it is “the nation’s leading provider of cloud-based technology products” (Opp. NOR Exh. 7), and that its “world-class, cloud-based platform answers the unique legal, regulatory, and compliance requirements posed by data stored ‘in the cloud’” (*id.* Exh. 10).

2. The phrase “Preservation Cloud”

Notably, Nextpoint makes no attempt to argue that the phrase “preservation,” in itself, is not descriptive of the Archiving Service, or the allegedly separate “Preservation Cloud” service. Nor could Nextpoint credibly do so, given the numerous statements in Nextpoint’s marketing literature to the effect that Cloud Preservation, and Preservation Cloud, are intended to “preserve” the user’s data. (*See, e.g.*, App. NOR Exh. 4, at 3

(Preservation Cloud is a “storage and processing resource to preserve and manage large volumes of ESI”); *id.* Exh. 5, at 1 (Preservation Cloud’s purpose is the “preservation of confidential data”); Opp. NOR Exh. 10 (Cloud Preservation is intended to meet “the challenge of preserving data generated on the internet”).)

Instead, Nextpoint asserts that the phrase “Preservation Cloud,” taken as a whole, “has no established meaning,” because “[t]here is . . . no such thing as a ‘preservation cloud.’” (App. Br. at 14.) Nextpoint is factually wrong, as others have indeed used the phrase “preservation cloud” to describe the use of cloud computing to preserve data. (*See, e.g.*, Opp. NOR Exh. 18 (article on “Digital Preservation Cloud Services”); *id.* Exh. 19 (“[T]he data preservation cloud is going to be the next big thing”); *id.* Exh. 20 (“The focus in a ‘preservation cloud’ is longevity, and the administrators of said cloud must think like digital curators”).)

In any event, whether others have previously used “preservation cloud” is irrelevant — the dispositive issue is whether the phrase describes one or more features of Nextpoint’s offerings. *See In re Hunter Fan Co.*, 2006 WL 479001, *3 (“[A] word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term . . . does not imbue the term with source-identifying significance.”); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 U.S.P.Q.2d 1100, 1997 WL 377630, *12 (TTAB Mar. 6, 1997) (“[I]t is not necessary that a designation be in common usage in the particular industry in order for it to be merely descriptive.”).

Nextpoint further insists that, because the USPTO has registered a number of other marks containing the word “cloud,” the Mark must therefore be registrable. (App. Br. at 14-19.) Nextpoint is mistaken, as “[t]hird party registrations . . . are not determinative of the question of registrability of [an] applicant’s proposed mark,” and

“[i]t is well settled that each case must be taken on its own facts.” *In re Sun Microsystems, Inc.*, 2001 WL 461279, *4; *see also In re Styleclick.com Inc.*, 2001 WL 245735, *4 (“[T]he determination of registrability of particular marks by the Trademark Examining Groups cannot control the result in another case involving a different mark for different goods and/or services.”); *In re Pennzoil Prods. Co.*, 1991 WL 326581, *6 (“Applicant’s reliance upon various third-party registrations is not persuasive of a different result,” because “each case must be decided on its own facts,” and “[w]e are not privy to the file records of the third-party registrations applicant has submitted and thus have no way of knowing whether any of those registrations involved an initial descriptiveness refusal . . .”). Nor does Nextpoint offer evidence that the third-party marks it relies upon were opposed on the ground of descriptiveness.

As consumers of electronic litigation support services, based on the context in which Nextpoint uses the term, would interpret “Preservation Cloud” as describing the features of Nextpoint’s offerings, the Mark is descriptive and not eligible for registration. *See* 15 U.S.C. § 1052(e)(1) (registration of mark must be refused if the mark, “when used on or in connection with the goods of the applicant[,], is merely descriptive . . . of them”).

II. NEXTPOINT HAS NO BONA FIDE INTENT TO USE THE MARK IN COMMERCE

A. Nextpoint’s Decision not to Use the Mark after Filing its Application Is a Valid Ground for Opposing Registration

Nextpoint’s assertion that there is no authority “for sustaining an opposition on the basis that a bona fide intent to use was subsequently relinquished” (App. Br. at 5) is incorrect. Numerous decisions by the Board have held that, when an applicant applies for a mark but later decides not to use it, the mark cannot be registered on an “intent to use”

basis. *See Spirits Int'l., B.V.*, 2011 WL 2909909, *3 (registration refused if the “applicant lacked on the filing date of the application, *or now lacks*, a bona fide intent to use the mark on the identified goods”) (emphasis added); *Swiss Army Brand Ltd. v. Dempsey*, No. 91175614, 2008 WL 1897566, *3 (TTAB Apr. 17, 2008) (granting summary judgment to opposer because “there is no genuine issue that applicant did not at the time he filed his application, *nor does he now*, have a bona fide intention to use his mark on . . . the goods identified”) (emphasis added); *PrimeCo Personal Comms., L.P. v. Teleport Comms. Grp., Inc.*, No. 113066, 2001 WL 253631, *1 (TTAB Feb. 14, 2001) (as “the record contains applicant’s clear admission that it *no longer has a bona fide intention* to use the involved marks in commerce,” registration refused) (emphasis added).

Nextpoint relies on *Speedway SuperAmerica LLC v. Renegade Tobacco Inc.*, No. 91124822, 2004 WL 2075108 (TTAB Sept. 2, 2004) (“*Speedway*”) (App. Br. at 5), but that case only confirms that Nextpoint’s abandonment of its intent to use the Mark invalidates its application. In *Speedway*, the Board stated that the relevant issues as to whether an intent-to-use application may be granted are (1) “whether applicant had a bona fide intention to use the mark in commerce at the time of filing the application,” and (2) “whether it *continues to have such an intent*.” *Id.* at *6 (emphasis added).

B. Nextpoint’s Documentary Evidence Does Not Show that Nextpoint Intended to Use the Mark After March 2010

Nextpoint claims that it “has supplied ample documentary support for its claim that it intends to use the Mark,” citing Exhibits 1 through 11 to its Notice of Reliance. (App. Br. at 8.) However, none of these documents meets the requirement that Nextpoint

possess “‘a written plan of action’ for a new product or service” to be designated by the Mark. *Bobosky*, 843 F. Supp. 2d at 1140 (quoting 3 MCCARTHY § 19.14, at 19-46, 47).

There is no dispute that, in late 2009 and early 2010, Nextpoint considered using the Mark to designate one of its services, a software tool that archived data from websites and social media (the “Archiving Service”), and mentioned the Mark on its website and in marketing e-mails. (Opp. NOR, Exh. 16, ¶ 5.) However, in January 2010, Nextpoint learned that CaseCentral’s Christopher Kruse owned the www.preservationcloud.com domain name. (*Id.*; *see also* Opp. NOR, Exh. 8, at 1.)

In March 2010, after a failed attempt to buy the domain name, Nextpoint chose not to call the Archiving Service “Preservation Cloud.” (Madhava Dep. 28:23-29:16; *see also* Opp. NOR, Exh. 14, at 3 (e-mail by Nextpoint’s Ben Wolf stating that “CloudPreservation might actually be a bit more accurate for this product”).) Afterward, Nextpoint stopped mentioning “Preservation Cloud” on its website (Beumer Dep. 15:4-15; *see also* Opp. NOR, Exh. 3), and ceased referencing the Mark in its marketing e-mails (Beumer Dep. at 18:24-19:9). Moreover, no Nextpoint customer is presently using a product called “Preservation Cloud.” (Madhava Dep. 28:8-22.)

Nextpoint makes no attempt to rebut this evidence. Instead, to show its purported intent to continue using the Mark, Nextpoint relies on a series of documents that, with one exception, date from *before* March 2010. (App. Br. at 8 (citing App. NOR, Exhs. 1-11).) The only document cited by Nextpoint that arguably dates from after March 2010, a brochure containing the statement “© 2011 Nextpoint Inc.,” has no discussion of what “Preservation Cloud” is, and states only that Nextpoint’s “Trial Cloud” service “[o]ffers

seamless integration from Preservation Cloud and Discovery Cloud.” (App. NOR, Exh. 11, at NEXT 4129.) This evidence lends no support to Nextpoint’s position:

1. Obsolete portions of Nextpoint’s website. Nextpoint’s Exhibits 1, 2, 9 and 10 are pages from Nextpoint’s website dating from 2010 (App. NOR Exhs. 1, 2, 9, 10) that, by Nextpoint’s admission, no longer exist. As Beumer admitted, Nextpoint no longer mentions Preservation Cloud on its website — consistent with Nextpoint’s abandonment of its intent to use the Mark. (Beumer Dep. at 15:4-15.)

2. Document making no mention of the Mark. Exhibit 3 is a draft press release that does not even reference the Mark. (App. NOR, Exh. 3.)

3. Undated brochure. Exhibit 4, a brochure, is undated (*id.* Exh. 4), and thus cannot serve as evidence that Nextpoint intended, after March 2010, to use the Mark in commerce. Notably, this document makes no mention of Cloud Preservation, suggesting that it dates from at least before April 2010, when Nextpoint applied for that mark. (Opp. NOR, Exh. 9 (CLOUD PRESERVATION application).)

4. Obsolete brochures. Exhibit 5 is a brochure that, on its face, dates from 2009 (App. NOR, Exh. 5), and thus does nothing to show that Nextpoint intended to use the Mark in commerce after March 2010. Moreover, Beumer and Madhava admitted that Nextpoint’s marketing materials no longer use the Mark. (Beumer Dep. 15:4-15 & 18:24-19:9; Madhava Dep. 22:5-14.)

Another brochure, Exhibit 11, is the only document relied on by Nextpoint listing a date after 2010, as the copyright line at the bottom of certain pages reads “© 2011 Nextpoint, Inc.” (App. NOR, Exh. 11.) However, this document does little to support Nextpoint’s claims. The brochure has pages specifically devoted to Cloud Preservation,

Discovery Cloud and Trial Cloud, but no page for Preservation Cloud. (*Id.* at NEXT 4125, 4127, 4129.) The only reference to Preservation Cloud is on the page dedicated to Trial Cloud, which states that Trial Cloud “[o]ffers seamless integration from Preservation Cloud and Discovery Cloud” (*Id.* at 4129.) Read in context, and given Beumer’s and Madhava’s testimony that Nextpoint does not use the Mark in its marketing materials, this reference to Preservation Cloud was, most likely, accidentally left in the document by the person who updated it to describe Cloud Preservation.

Further, although this document lists a copyright date of 2011, Madhava admitted that a similar brochure bearing a 2011 copyright date was actually used during the first quarter of 2010 (Madhava Dep. at 30:2-31:5 & Exh. 2), and thus it is unclear when this brochure was actually created. Nor is it clear whether Nextpoint actually used this brochure to advertise Preservation Cloud, or any other service.

5. Pre-March 2010 press release: Exhibit 6 is a November 12, 2009 press release referencing the Mark. (App. NOR, Exh. 6.) Again, this document does nothing to show that Nextpoint intended to use the Mark after March 2010.

6. Pre-March 2010 blog posts: Exhibits 7 and 8 date, respectively, from November 2009 and January 2010 (*id.* Exhs. 7, 8), and thus, again, do not support Nextpoint’s claim to possess a present intent to use the Mark.

As none of these documents reflects that Nextpoint intends, at present, to use the Mark in commerce, Nextpoint fails to meet the bona fide intent requirement. *See DC Comics & Marvel Characters, Inc. v. Silver*, No. 91176744, 2009 WL 4085622, *6 (TTAB Aug. 21, 2009) (applicant’s evidence did not show bona fide intent to use mark, as (1) applicant’s “checklist, which is undated and unsupported by a declaration or

affidavit,” does not “relate specifically to the SUPER HERO mark,” and “applicant does not indicate that he actually performed any of the tasks listed thereon”; and (2) “nothing in the record indicates that the handwritten note” submitted by applicant “was prepared contemporaneously with the filing of the application”); *see also SmithKline Beecham Corp. v. OmniSource DDS, LLC*, 97 U.S.P.Q.2d 1300, 2010 WL 5099661, *5 (TTAB Nov. 29, 2010) (because “[n]o reference is made in the minutes” of meetings produced by applicant “either to the AQUAJETT mark or the oral irrigators identified thereby, let alone any plans to build, license, market or sell such goods,” evidence submitted by applicant failed to show intent to use mark).

Nextpoint’s authorities regarding the documentary evidence required to show intent to use a mark (App. Br. at 6-7) are not to the contrary.

Pfizer, Inc. v. Hamerschlag, No. 118181, 2001 WL 1182865, *2 (TTAB Sept. 27, 2001), concerned an opposer’s motion for summary judgment based on lack of intent to use the mark, not a trial. *Id.* at *2 (noting that “the factual question of intent is particularly unsuited to disposition on summary judgment”). Moreover, the applicant in *Pfizer* testified that “his intention was to develop the product upon completion of the registration process,” whereas Nextpoint, undisputedly, considered using the Mark to designate the Archiving Service, but chose *not* to do so. *Id.*

In *Kellogg Co. v. Earthgrains Co.*, No. 91110121, 2003 WL 22273096 (TTAB Sept. 30, 2003), the applicant had “prepared labels for use during test marketing for the product,” and “used the mark . . . on packaging for test marketing the product.” *Id.* at *2. Here, there is no evidence that Nextpoint is marketing a product using the name

“Preservation Cloud,” and Nextpoint’s witnesses testified that Nextpoint is not doing so. (Beumer Dep. 15:4-15 & 18:24-19:9; Madhava Dep. 22:5-14.)

Similarly, in *Blair Corp. v. Fassinger*, No. 91166414, 2008 WL 4674607 (TTAB Oct. 17, 2008), the evidence showed that “applicant has undertaken steps to acquire manufacturing capabilities and promotional activities (*i.e.*, publishing her book) so that the MALLORY VALERIE BLAIR character becomes a desirable ‘brand.’” *Id.* at *5. There is no evidence that Nextpoint, after March 2010, took any similar steps.

Finally, in *Speedway*, the evidence showed that (1) “graphic work was performed on the SPEEDWAY package in the year of the filing of the application as well as the year immediately following the filing,” and (2) “applicant wanted to introduce the lower-priced TUCSON brand, which it has now done, before introducing the higher-priced SPEEDWAY brand into the market.” *Speedway*, 2004 WL 2075108, *7. Here, the record contains no evidence that Nextpoint is preparing to launch a “Preservation Cloud” product, and the only evidence, as noted above, reflects that Nextpoint abandoned its intent to launch such a product.

C. Nextpoint’s Executives’ Assertion that They Intend to Use the Mark at an Unknown Future Date Is Insufficient to Establish Intent to Use

Apart from documents dating from before Nextpoint’s discovery that CaseCentral’s Christopher Kruse owned the preservationcloud.com domain name, Nextpoint’s only evidence of its supposed intent to use the Mark going forward consists of Madhava’s and Beumer’s testimony. (Madhava Dep. 22:2-4; Beumer Dep. 18:4-9.) As Beumer admitted, Nextpoint does not know when it intends to use the Mark again. (Beumer Dep. 18:4-23.)

Nextpoint's executives' assertion that they intend to use the Mark at an uncertain future date is insufficient to show that Nextpoint has such an intent. *See Loreal S.A.*, 2012 WL 1267956, *13 ("Applicant's mere statements that he intends to use the mark L'OREAL PARIS, and his denial that he lacked a bona fide intent, do not establish, in fact, that he had a bona fide intent to use the mark in commerce"); *Bobosky*, 843 F. Supp. 2d at 1140 (applicant's "subjective testimony about [its] state of mind cannot demonstrate that [it] possessed a bona fide intent to use" the mark at issue); *Padres L.P. v. Munoz*, No. 91187852, 2010 WL 1720596, *3 (TTAB Apr. 15, 2010) (applicant's "mere statements of subjective intent do not suffice to establish bona fide intent").

Moreover, even if Nextpoint's witnesses' testimony sufficed to show the requisite intent, the testimony relied upon by Nextpoint (App. Br. at 8) reflects only Nextpoint's *past* intent, during the late 2009-early 2010 period, to use the Mark in commerce, not any present intent to do so. Nextpoint cites Madhava's statement that "[t]he way we *had* marketed Preservation Cloud and taken it to market as a large-scale archival service" (Madhava Dep. 5:3-11 (emphasis added)) as evidence of "the extensive development history of the Data Management Service" (App. Br. at 8). However, Madhava admitted that "we are not as part of our current marketing lineup discussing Preservation Cloud as a discrete service." (Madhava Dep. 11:8-13.) Similarly, Nextpoint points to Beumer's testimony that, with respect to Preservation Cloud, "we *mentioned* it on the website," "in our brochures," and in "e-mail blasts." (Beumer Dep. 5:17-23 (emphasis added).) Nextpoint, however, ignores Beumer's later statements that "Preservation Cloud . . . is not currently mentioned on our website" (*id.* at 15:10-12), and Nextpoint is not referring to the Mark in its "e-mail blasts" today (*id.* at 19:4-9).

D. “Cloud Preservation” and “Preservation Cloud” Are Not Distinct Products, but even if They Are Distinct, the Evidence Nonetheless Shows Nextpoint Lacks a Bona Fide Intent to Use the Mark

Finally, Nextpoint claims CaseCentral’s “argument rests almost entirely on its theory . . . that Nextpoint’s Data Management Service and its Web Archiving Service are identical products” (App. Br. at 9.) Nextpoint is incorrect. Regardless of whether Nextpoint ever contemplated using the Mark to designate a product other than the Archiving Service, Nextpoint has not rebutted the evidence that, after it discovered that CaseCentral’s Kruse owned the preservationcloud.com domain name, Nextpoint ceased using the Mark for *any* purpose. (*See, e.g.*, Opp. NOR Exh. 14, at 3; Madhava Dep. 28:23-29:16 (Nextpoint chose not to call the Archiving Service “Preservation Cloud” because CaseCentral owned the domain name).) Nor is there evidence that, after March 2010, Nextpoint made a concrete plan to resume using the Mark.

In any event, Nextpoint’s evidence for the implausible claim that it intends to simultaneously offer different products called “Preservation Cloud” and “Cloud Preservation” is unconvincing. Nextpoint claims its marketing materials describe the two products “quite differently,” as those materials allegedly state that Preservation Cloud “preserve[s] and manage[s] large volumes of ESI,” *i.e.*, electronically stored information, while they describe Cloud Preservation as “archiv[ing] and index[ing] data from” websites and social media. (App. Br. at 9-10.) However, the fact that Preservation Cloud allegedly focuses on “electronically stored information” does not distinguish it from Cloud Preservation. “Electronically stored information,” as that term is commonly used, includes data from social media platforms like Twitter and Facebook, which is the type of data Cloud Preservation collects. *See EEOC v. Original Honeybaked Ham Co. of Ga.*,

Inc., No. 11-cv-02560, 2013 WL 753480, *1 (D. Colo. Feb. 27, 2013) (referencing “the search of electronically stored information including social networking data”); *EEOC v. Simply Storage Mgmt., LLC*, 270 F.R.D. 430, 432, 434 (S.D. Ind. 2010) (referring to “internet social networking site (SNS) profiles” as “electronically stored information”).

Similarly, Nextpoint’s assertion that the “pricing structures” of the purportedly distinct services “are different” (App. Br. at 10) is unsupported. The documents cited by Nextpoint that supposedly describe Preservation Cloud’s pricing (App. NOR Exhs. 7, 10) consist of (1) an excerpt from Nextpoint’s website (*id.* Exh. 10), which, by Nextpoint’s admission, no longer mentions Preservation Cloud (Beumer Dep. 15:4-15); and (2) a Nextpoint blog post from January 2010 (App. NOR Exh. 7), which dates from before Nextpoint’s decision not to use the Mark in March 2010. Those documents are outdated, and are not evidence of Preservation Cloud’s current, alleged “pricing structure.”

Nor do the “description[s] of goods contained in the respective trademark applications for PRESERVATION CLOUD and CLOUD PRESERVATION” (App. Br. at 10) support Nextpoint’s claim that Preservation Cloud and Cloud Preservation are different products. Nextpoint’s application for PRESERVATION CLOUD states that the Mark will be used to designate, *inter alia*, “an internet-based integrated suite of applications . . . that include” the “functionality” of “search engine and search index generation” (Opp. NOR, Exh. 23, at 4), which is consistent with Nextpoint’s description of Cloud Preservation as “archiv[ing] and index[ing] data from your company websites, blogs, and social media sites” (*id.* Exh. 11). Moreover, Nextpoint’s application for the Mark does not purport to describe a single product at all, but rather an “integrated suite of applications.” (*Id.* Exh. 23, at 4.)

Finally, and tellingly, Madhava did not acknowledge the alleged difference between “Cloud Preservation” and “Preservation Cloud” in correspondence with a prospective client. In a May 2, 2011 e-mail, Madhava wrote that “Preservation Cloud” related to “social media and website archiving” (Madhava Dep. Exh. 3), contrary to his own testimony that Preservation Cloud was not used for archiving social media data, but for “low-cost archival of large volumes of legacy ESI” (*id.* 23:18-19).

CONCLUSION

For the foregoing reasons, registration of the Mark should be refused.

Date: June 11, 2013

Respectfully submitted,

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CASECENTRAL, INC.,)	
)	Mark: PRESERVATION
)	CLOUD
vs.)	
)	Serial No.: 77/922,469
NEXTPOINT, INC.,)	
)	Opposition No. 91198858
)	
Applicant.)	Published in the Official
)	Gazette on November 9, 2010
)	

**OPPOSER CASECENTRAL, INC.'S RESPONSE TO
APPLICANT'S OBJECTION TO REQUEST FOR JUDICIAL NOTICE**

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Nextpoint objects to CaseCentral's Request for Judicial Notice dated April 4, 2013 ("RJN"), asserting that (1) the RJN is supposedly untimely, and (2) "the fact that the document . . . attached to [the RJN] as Exhibit A was sent to Nextpoint on January 27, 2011" is not a proper subject of judicial notice. (Nextpoint's Obj. to RJN, May 6, 2013 ("Obj.") at 2.) Nextpoint is incorrect.

First, Nextpoint asserts that CaseCentral was required to submit its RJN during CaseCentral's testimony period. However, Trademark Board Manual of Procedure ("TBMP") Rule 704.12(d) provides that "[j]udicial notice may be taken at any stage of a Board proceeding, even on review of the Board's decision on appeal." TBMP R. 704.12(d); *see also* Fed. R. Evid. 210(f) ("Judicial notice may be taken at any stage of the proceeding."); *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 U.S.P.Q. 1385, 1999 WL 1288981, *10 (TTAB Dec. 29, 1999) (Board properly "takes judicial notice of the following dictionary definitions, which have not previously been made of record by either party herein"). Moreover, Nextpoint does not, and cannot, claim that CaseCentral's submission of the RJN prejudiced Nextpoint. CaseCentral's RJN was filed before Nextpoint's opening brief (which was filed on May 6, 2013), and thus Nextpoint had every opportunity to respond, whether in its brief or by its own request for judicial notice. *See In re RCG Inc.*, No. 77852698, 2011 WL 1495457, *1 (TTAB Mar. 31, 2011) (dictionary definition properly judicially noticed, because "the examining attorney had an ample opportunity to respond to the dictionary definition in her brief").

Litton Bus. Sys., Inc. v. J.G. Furniture Co., 190 U.S.P.Q. 428, 1967 WL 20938 (TTAB Jan. 26, 1976) ("*Litton*"), on which Nextpoint relies (Obj. at 1), is not to the contrary. In *Litton*, the petitioner failed to submit evidence during its trial period, and the

respondent thereafter moved for judgment in its favor. *Id.* at 430. The petitioner then filed a request for judicial notice, which the Board denied on the ground that, “at the time that respondent’s motion for judgment . . . was filed, . . . there was no signal from petitioner that it intended to attempt to rely on judicially noticed facts to prove its case” *Id.* Here, in contrast, Nextpoint had every opportunity to respond to CaseCentral’s RJN.

Second, Nextpoint maintains that “the fact that the document” CaseCentral “has attached to its request as Exhibit A was sent to Nextpoint on January 27, 2011 . . . is not a fact that is either generally known or capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” (Obj. at 2.)

However, CaseCentral submitted Exhibit A to the RJN to establish that Exhibit A was filed with the court in the litigation between Opposer and Applicant styled *Nextpoint, Inc. v. CaseCentral, Inc.*, Case No. 10-CV-3515 (N.D. Ill., Jun. 8, 2010), and that is a proper purpose. *See William Carter Co. v. H.W. Carter & Sons, Inc.*, No. 91111355, 2004 WL 506139, *3 (TTAB Feb. 27, 2004) (taking judicial notice of publicly available “copy of the court’s (slip opinion) decision in the parties’ prior litigation”); *Am. Optical Corp. v. Am. Olean Tile Co.*, 169 U.S.P.Q. 123, 125 (TTAB 1971) (“Certificate of Good Standing” from U.S. District Court admissible as official record).

Date: June 11, 2013

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CERTIFICATE OF SERVICE

I, Christopher R. Edgar, am over the age of eighteen and not a party to the above-referenced action. On June 11, 2013, I served the following documents by first-class mail:

OPPOSER'S REPLY BRIEF

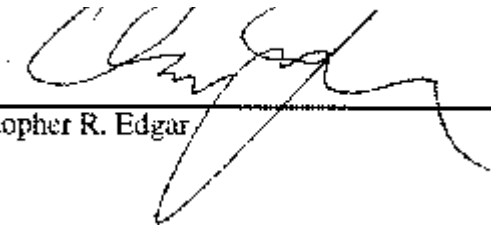
RESPONSE TO OBJECTION TO REQUEST FOR JUDICIAL NOTICE

I served the foregoing documents by first-class mail on the counsel listed below:

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Attorneys for Applicant Nextpoint, Inc.

I declare under penalty of perjury that the foregoing is true and correct.

Dated: June 11, 2013



Christopher R. Edgar